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No. 71-485

Supreme Court, U.S.
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IN THE

Supreme Court of the United States

OCTOBER TERM, 1971

ROBERT GOTTSCHALK, Acting Commissioner of Patents,
Petitioner,

v.

GARY R. BENSON AND ARTHUR O. TABBOT, *Respondents*.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

BRIEF FOR RESPONDENTS IN OPPOSITION

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QUESTION PRESENTED

Whether respondents' claimed process of converting electrical signals by machine is a "useful process" within the meaning of 35 U.S.C. § 101.

STATEMENT

Respondents filed a patent application disclosing a novel machine method for converting signals encoded in the binary coded decimal (BCD) notation into signals encoded in the ordinary binary notation. Although this process can be performed on most general purpose stored program computers, its practical use as the preferred method is far more limited. Respondents have incorporated their invention in a stored-program-controlled electronic telephone switch-

ing system for converting dial signals into binary signals, and it is in this particular equipment that the invention is most useful.

Many other machine processes for converting binary coded decimal signals to binary signals were known prior to respondents' invention, and have been and will continue to be used generally to perform this function. Respondents' specific contribution was in response to a need for less apparatus complexity, reduced memory requirements and faster conversion in certain types of computers. Respondents' invention achieved these objectives by providing a novel combination comprising a short and simple sequence of steps which could be performed iteratively.

The Patent Office rejected respondents' claims on the sole ground that they related to subject matter which was not embraced by 35 U.S.C. § 101. The court below unanimously reversed, holding that "a process having no practical value other than enhancing the internal operation of * * * [computer] machines is * * * in the technological or useful arts * * *." (Pet., p. 31)

ARGUMENT

The decision below is in full accord with established principles of law, conflicts with no decision of this or any other Court, and presents no appropriate occasion for the exercise of this Court's rarely utilized jurisdiction under 28 U.S.C. § 1256.

There is no dispute that respondents have invented a process that is both "new" and "useful." That process enables certain types of machines to be operated far more efficiently than was previously the case. This Court has consistently held that technological or industrial processes are patentable. *Smith* v. *Snow*, 294 U.S.

1 (artificial incubation); *Expanded Metal Co.* v. *Bradford,* 214 U.S. 366 (mechanical metal forming); *Tilghman* v. *Proctor,* 102 U.S. 707 (fat treatment); *Cochrane* v. *Deener,* 94 U.S. 780 (flour processing).[1] Technological processes which, like respondents' processes, rely on acts performed on electrical signals have likewise consistently been held by this Court to constitute statutory subject matter. *The Telephone Cases,* 126 U.S. 1 (telephony); *O'Reilly* v. *Morse,* 15 How. 62 (telegraphy).

The suggestion that the decision of the court below results in the allowance of a patent on "mathematical theories and mental steps" (Pet., p. 8) is basically fallacious. As the court below recognized, respondents' claims are directed to a particular sequence of machine steps, designed to accomplish a particular result.[2] In respondents' invention these steps are performed on electrical signals when certain coded instructions are executed. The process is no more one of "mathematical theories and mental steps" than it would be if it were accomplished by use of specially designed wired circuitry (a permanent physical part of a machine), on which many patents have issued without challenge by petitioner. Indeed, it could be so accomplished, since it is well known that computer

[1] It may be noted that in each of the decisions of this Court cited in the Petition (at p. 9) for the proposition that scientific principles and the like are not patentable the Court recognized that statutory subject matter was in fact present, although not properly claimed in every case.

[2] The construction of the claims by the court below was commanded by Section 112 of the Patent Code, 35 U.S.C. § 112. This construction, tying the claims to machine implementation, has not been challenged by petitioner. Any such challenge would in any event have raised no issue appropriate for this Court's resolution.

or logic operations can be performed either with wired circuitry or programming. See Kovacic, *Programmed or Wired Logic—Which Is Best For Your Control?* 14 Control Engineering 120 (Jan. 1967). There is no basis in the patent statute or in case law for suggesting that a process involves statutory subject matter if performed by a permanently-wired-together electrical circuit but does not if, as here, it is performed by a programmed machine. The latter no more than the former can properly be characterized as consisting simply of "mathematical theories and mental steps." In both instances the process covers steps in the operation of a machine for the purpose of achieving a specific result.[8]

Petitioner's claim that the holding below conflicts with two decisions rendered by the Ninth Circuit some decades ago (Pet., pp. 11-12) is without merit. In both of the cited cases the heart of the claimed invention was a mathematical computation to be undertaken by human agency. Here, in contrast, respondents have expressly disclosed program-controlled apparatus for practicing each and every step of their invention, without any human intervention, and the court below has specifically interpreted the patent claims as entirely tied to the operation of machines.

The argument that the decision below will have a serious impact on the computer industry (Pet., p. 12) is

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[8] Cf. Cochrane v. Deener, 94 U.S. 780, 788: "A process is a mode of treatment of certain materials to produce a given result." Such "materials" include, as is the case here, electricity. The Telephone Cases, 126 U.S. 1. The effect of the *Cochrane* case is thus, contrary to petitioner's suggestion (Pet., pp. 10-11) "not to limit process patentability but to point out that a process is not limited to the means used in performing it." Application of Prater and Wei, 415 F.2d 1393, 1403 (C.C.P.A. 1969).

entitled to no weight. That argument could as readily be made with respect to the patentability of inventions in computer hardware, and indeed if accepted could be used to justify wide preclusion of patentability in any industry where inventive technology plays a significant role. There is no discernible reason why an inventor who can meet the stringent standards of patentability laid down by this Court in *Graham* v. *John Deere Co.*, 383 U.S. 1, should be deprived of his statutory rights here more than in any other circumstances.

Similarly, the suggestion that the Patent Office will be quite overwhelmed if this invention and others like it are allowed patentability (Pet., p. 14) is not worthy of serious consideration. The suggestion ignores the fact that in no event will more than a small fraction of new computer processes meet the rigorous tests of invention and a smaller fraction still are likely to be the subject of patent applications in view of economic and other practical restraints. And so far as any problem of searching the prior art is concerned, the Patent Office will in any event have to search the field within which respondents' invention stands in connection with the examination of applications for patents on computer hardware.[4]

The nature of the arguments of petitioner that have just been discussed is, indeed, itself a reason for denying the writ. These arguments invite the Court to explore questions of policy that require the consideration of a wide range of broad economic and technologi-

[4] The Patent Office is no stranger to the use of sophisticated retrieval systems. It is in the advanced planning stages of a computer-aided classification and retrieval system designed to cope with the tremendous volume of prior art being generated in all technologies.

cal problems. This is not an appropriate case for the resolution of such questions. The invention here involved is limited both in its nature and in its economic significance. Moreover, the decision of the court below was an appeal from a proceeding in the Patent Office in which the record essentially consists solely of legal assertions and counter-assertions by respondents' attorneys and Patent Office examiners.[5] If the question that the petition seeks to present is in fact of the broad and general importance suggested, and if the circumstances adverted to in the petition in fact bear on its proper resolution, it is particularly desirable that it be considered by this Court only on a record where these and other circumstances can be fully developed in an adversary context, as in an infringement action. Compare *White Motor Co.* v. *United States*, 372 U.S. 253.

CONCLUSION

For the foregoing reasons, the petition should be denied.

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[5] The only factual evidence adduced in the proceeding, *viz.* certain prior art, was not involved in the appeal to the court below.